| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/486,258 | 06/07/95 | HARVEY | J 5534.361 |

26M2/1223

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| EXAMINER |
|---|
| VU,N |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2604 | 5 |

**DATE MAILED:**
12/23/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

# OFFICE ACTION SUMMARY

☑ Responsive to communication(s) filed on _12-7-95_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed in** accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ___3___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☑ Claim(s) _6-29_ is/are pending in the application.

☐ Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) _6-29_ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

**Application Papers**

☑ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☑ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☑ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –

PTOL-326 (Rev. 10/95)   ★ U S GPO: 1996-409-290/40029

1.    This action is in response to the amendment filed December 7, 1995.

2.    This action will not attempt to determine the effective filing date of this application.   The action will apply art against the claims using two possible effective filing dates, i.e. serial number 06/317,510, filed November 3, 1981, and serial number 07/096,096, filed September 11, 1987.   Applicants can overcome the art rejections by establishing that the art applied does not meet the claimed limitations or that the art does not have an early enough filing date.

The action will make initial double patenting rejections presuming that all of the present claims were fully disclosed in both the '81 and '87 cases.

In any rejections made under 35 USC 112, first paragraph, applicants will be asked to clarify, where required by the examiner, how the present claims are fully disclosed in both the '81 and '87 cases.

3.    Applicants are reminded of their duty to maintain a line of patentable demarcation between related applications.   It has been noted by the PTO that many of the pending applications have similar claimed subject matter.   In the related 327 applications (the serial numbers are included in a list below), it is estimated that there may be between 10,000 and 20,000 claims. Applicants should insure that substantially duplicate claims do not appear in different cases, and should bring to the PTO's

attention instances where similar claims have been treated
inconsistently, i.e. rejected in one case but not in another.

4.   Applicants are cautioned that their continual use of
alternatives in the claims raises questions concerning the exact
claim meaning.  More importantly, it raises questions whether the
disclosure supports every possible embodiment or permutation that
can be created by the alternative language.

5.   The double patenting rejections in this action are based on
the premise that all of the present claims were fully disclosed
in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414.
Since there was a restriction made in 5,233,654, there will be no
double patenting made on that patent or 5,335,277.

6.   The PTO's copies of the parent files are in poor form since
they have been copied many time by members of the public.  The
files also are missing some of the papers.  The double patenting
rejections below presumes that there were no requirements for
restriction made in any of the parent files.

7.   There are three types of double patenting rejections:

     a)   Statutory double patenting rejection under 35 USC 101,

     b)   Nonstatutory obvious type double patenting,

     c)   Nonstatutory non-obviousness type double patenting.

In this action, the rejections of the third type that are
directed to the claims of the parent patented files will have two
different versions.  The first rejects the claims because they
have not been established to be independent and distinct from the

patented claims.  The second version includes that premise, and
further supports the rejection by establishing that
representative claims from this application have common subject
matter with representative ones of the patented claims.

8.    Claims 6-29 (all of the claims in this application) are
rejected under the judicially created doctrine of non-obviousness
non-statutory double patenting over the patented claims in U.S.
Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414 since the
claims, if allowed, would improperly extend the "right to
exclude" already granted in those patents.

The subject matter claimed in the instant application is
fully disclosed in the patents and is covered by the patents
since the patents and the application are claiming common subject
matter, as follows: a signal processing apparatus and method
including an interactive communications system apparatus and
method.  Furthermore, there is no apparent reason why applicants
were prevented from presenting claims corresponding to those of
the instant application during prosecution of the parent
applications which matured into patents.  *In re Schneller*, 397
F.2d 350, 158 USPQ 210 (CCPA 1968).  See also MPEP § 804.

A review of the claims in each of the four parent patents
(5,109,414; 4,964,825; 4,704,725; 4,694,490) was made.  These
patented claims do not appear "independent and distinct" from the
claims in this application.  The present claims are directed to a
method and apparatus for controlling communications including

television communications or programming.  The claims in patent

5,109,414 were directed to a processing system and method for

signal distribution including television.  The claims in patent

4,965,825 were directed to a system and process for signal

processing including carrier communications.  The claims in

patent 4,704,725 were directed to a method of communicating data

to receiver stations.  The claims in patent 4,694,490 were

directed to a method for communicating and processing television

programs.

Applicants' invention can be envisioned at in three parts.

As with most cable TV systems, there is a head end station which

generates the video programming.  Applicants have included an

intermediate station which receives transmissions, from the head

end or subscriber stations, and distributes the programming to

each subscriber.  The subscriber station receives the

programming, and can communicate to the intermediate station with

requests or instructions.  Even if the claims directed to each

station were "independent and distinct" from the claims directed

to the other stations, there would be no reason to "restrict"

between the three stations since their overall function is so

interrelated that the stations have the same search area, i.e the

PTO could not establish a burden if required to search for all

three stations.

It is believed that CCPA in *Schneller* used the "independent

and distinct" standard as the main factor in its determination

that the double patenting rejection should be affirmed.  The CCPA

stated that the fundamental reason supporting the principle of

non-statutory double patenting rejections is to prevent

unjustified timewise extension of the right to exclude granted by

a patent no matter how the extension is brought about.  Further

the CCPA stated at 158 USPQ 210 (214):

> "... To conform to this reason and to prevail here,
> appellant has the burden of establishing that the invention
> in his patent is "independent and distinct" from the
> invention of the appealed claims.  The public policy
> considerations underlying 35 U.S.C. 121 permit separate
> patents on "independent and distinct" inventions which are
> initially "claimed in one application."  The statute places
> initial responsibility for this determination on the
> Commissioner of Patents.  Where, as here, no such
> determination has been made, it is necessary to scrutinize
> carefully an applicant's voluntary alleged determination of
> this issue for it can lead to the improper proliferation of
> patents on the same invention with the inherent result of
> extending timewise a patentee's right to exclude others from
> the invention disclosed in the original application and on
> which his patent has issued."

The CCPA further stated at page 215 the length of time between an

earlier patent and a later filed application should be

considered.  The filing date of this application was over seven

years after the first patent issued (serial number 06/317,510,

filed November 3, 1981, patented as 4,694,490 on September 15,

1987) and over four years after the first CIP issued as a patent

(serial number 07/096,096, filed September 11, 1987, patented as

4,965,825 on October 23, 1990).

To the extent that one would view *Schneller* and *In re*

*Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) to be in

conflict, it is clear that *Schneller* is the controlling precedent

to the factual situation here.  In *Schneller*, the Court
specifically distinguished a situation of the same applicant from
one where the application and patent had different inventive
entities.  In *Kaplan*, the inventive entities between the patent
and application were different, as was required at the time of
the Kaplan invention, since Kaplan's filing date was before the
Patent Law Amendments Act of 1984.  In this present case, as with
*Schneller*, the inventive entities of the application and patent
are the same.  Clearly, Kaplan was required, or entitled, to file
separate applications, whereas applicants and Schneller did not
have reason to do so.  Finally, decisions of a three-judge panel
of the Federal Circuit cannot overturn prior precedential
decisions of the CCPA.  See *UMC Elec. Co. v. United States* 2
USPQ2d 1465.

9.    Claims 6-29 (all of the claims in this application) are
rejected under the judicially created doctrine of non-obviousness
non-statutory double patenting over the patented claims in U.S.
Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414 since the
claims, if allowed, would improperly extend the "right to
exclude" already granted in those patents.

This rejection incorporates the rejection above.  That
double patenting rejection is further supported by *Schneller*
because the great majority of the patented claims are

"comprising" type claims.[1]  While it is recognized that the
specific claim limitations in the application may not have been
claimed in the patents, that alone does not establish grounds for
overcoming this rejection.  The patent claims were directed to
parts of applicants' total disclosed system or process.
Therefore the recitation of "comprising" enables those patented
claims to "cover" claim features now recited by applicants'
present application claims.

Since the head end, intermediate, and subscriber stations
are part of the overall system, claims to one part "cover" the
other part(s) under the *Schneller* decision (page 215), since the
preferred embodiment would include all three parts of the main
system, i.e. head, intermediate, and subscriber stations.  For
example, claims to the subscriber station still cover the
intermediate station because the subscriber station would be
processing information that had to come from the intermediate
station.  A second example would be that claims to one aspect or
function of the intermediate station would cover the invention of
another aspect or function of the intermediate station since both
functions could be performed with the other.  Applicants'
disclosed system includes similar features in the head,
intermediate, and subscriber stations.  For example, the stations

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[1]The claims that recite neither "comprising" nor
"consisting" are considered to recite open claim language, i.e.
equivalent to "comprising".  See, for example, claim 1 of Patent
5,109,414.

can transmit and receive, and have computer, processor and

controller capabilities.  For that reason, the disclosure will

permit broadly drafted claims to read on either the head,

intermediate, or subscriber station.  Patent claims that recite

receiving and transmitting can cover both intermediate and

subscriber stations.  The fact that patent claims and application

claims are directed to different elements does not prohibit this

rejection if there is common or interrelated subject matter

recited.  The Court in *Schneller* stated at page 215:

> "... They "cover" the preferred form ABCXY, common to the
> patent and this application, in the same sense.  The fact
> that X and Y are distinct elements, performing, independent
> functions, so that either can be employed without the other,
> does not change this fact.  Neither does appellant's
> omission of reference to the lip Y from his patent claims."

Application claim 16 is a representative claim.  It is

directed to a method of controlling a transmitter station by

receiving data and delivering it to a transmitter, the data

comprising an instruct signal effective to coordinate

presentation of the data with a second presentation sequence,

receiving control signals which control the communication of the

data, and transmitting the control signals.

A review of representative ones of the patented claims will

demonstrate that the patented claims cover the invention claimed

in this application:

a)    In patent 4,694,490, claim 7 is representative of the

claimed method for communicating TV program information to a

receiver station.  The receiver station receives the video

data, displays it, detects the presence of overlay

information using an instruct signal, and has computers

generate and transmit this overlay info to the display.

b)    In patent 4,704,725, claim 3 is representative, and, as

summarized below, recites a method of communicating data

comprising:

    a)    multiple receivers, each with a computer,
    b)    transmitting instruct to transmit signals to the
        computers,
    c)    detecting the signals and coupling them to the
        selected computers,
    d)    having the computers control their own selected
        output device.

c)    In patent 4,965,825, claim 24 is representative, and,

as summarized below, recites generating a computer output

having the steps of:

    a)    having multiple receivers, each with a computer,
    b)    transmitting an instruct to generate signal to the
        computers,
    c)    causing the computers to generate individual user
        output information.

d)    In patent 5,109,414, claim 15 is representative, and,

as summarized below, recites a signal processing system

(including):

    a)    receiver/distribution means,
    b)    switch means,
    c)    control signal detector means for transferring
        data to storage means,
    d)    storage means for storing and transferring data to
        processor means,
    e)    processor means for controlling.

While claim 15 is an apparatus claim, a method claim and

apparatus claim do not in themselves establish groups that

are  "independent and distinct".

The patented claims are also primarily directed to methods or

structure to control element(s) either directly at that station

or at another remote station.  This control is generally

completed with the reception or recognition of an instruct

signal.  The same common concept exists in application claim 16.

All of the claims, both patented and pending in this application,

when considered together, effectively recite parts of the

preferred embodiment, i.e. a head, intermediate, and subscriber

station.  The patented claims "cover" the claims of the

application because the patented limitations do not exclude the

limitations of this application.

In the arguments above, the examiner, when discussing

several of the patents, stated that the patented claims were

broad enough to read on multiple stations.  While it is believed

this analysis is correct, it is not critical to this rejection.

Since the patented claims recite limitations that are

interrelated with other similar features claimed in this

application, it is the examiner's position that those patented

claims "cover" the application claims because all of these

claimed features (both in the patent and application) describe

what is effectively the preferred embodiment.

The claims in this application, if allowed without a
terminal disclaimer, would continue patent protection of the
preferred embodiment, i.e. the complete system of the head,
intermediate, and subscriber stations, beyond the expiration of
applicants' parent patents.

10.   A determination of a possible non-statutory double patenting
rejection obvious-type in each of the related 327 applications
over each other will be deferred until a later time.  This action
is taken if view of the possibility that many of these
applications may be abandoned or merged.

11.   Claims 6-29 are rejected under the judicially created
doctrine of double patenting over the claims of copending U.S
application 08/113,329 and the following related U.S applications
(all of the application are series 08):

| # | Ser. No. | # | Ser. No. | # | Ser. No. |
|---|----------|---|----------|---|----------|
| 1 | 397371 | 2 | 397582 | 3 | 397636 |
| 4 | 435757 | 5 | 435758 | 6 | 437044 |
| 7 | 437045 | 8 | 437629 | 9 | 437635 |
| 10 | 437791 | 11 | 437819 | 12 | 437864 |
| 13 | 437887 | 14 | 437937 | 15 | 438011 |
| 16 | 438206 | 17 | 438216 | 18 | 438659 |
| 19 | 439668 | 20 | 439670 | 21 | 440657 |
| 22 | 440837 | 23 | 441027 | 24 | 441033 |
| 25 | 441575 | 26 | 441577 | 27 | 441701 |
| 28 | 441749 | 29 | 441821 | 30 | 441880 |
| 31 | 441942 | 32 | 441996 | 33 | 442165 |
| 34 | 442327 | 35 | 442335 | 36 | 442369 |
| 37 | 442383 | 38 | 442505 | 39 | 442507 |
| 40 | 444643 | 41 | 444756 | 42 | 444757 |
| 43 | 444758 | 44 | 444781 | 45 | 444786 |
| 46 | 444787 | 47 | 444788 | 48 | 444887 |
| 49 | 445045 | 50 | 445054 | 51 | 445290 |
| 52 | 445294 | 53 | 445296 | 54 | 445328 |
| 55 | 446123 | 56 | 446124 | 57 | 446429 |
| 58 | 446430 | 59 | 446431 | 60 | 446432 |
| 61 | 446494 | 62 | 446553 | 63 | 446579 |
| 64 | 447380 | 65 | 447414 | 66 | 447415 |
| 67 | 447416 | 68 | 447446 | 69 | 447447 |
| 70 | 447448 | 71 | 447449 | 72 | 447496 |
| 73 | 447502 | 74 | 447529 | 75 | 447611 |
| 76 | 447621 | 77 | 447679 | 78 | 447711 |
| 79 | 447712 | 80 | 447724 | 81 | 447726 |
| 82 | 447826 | 83 | 447908 | 84 | 447938 |
| 85 | 447974 | 86 | 447977 | 87 | 448099 |
| 88 | 448116 | 89 | 448141 | 90 | 448143 |
| 91 | 448175 | 92 | 448251 | 93 | 448309 |
| 94 | 448326 | 95 | 448643 | 96 | 448644 |
| 97 | 448662 | 98 | 448667 | 99 | 448794 |
| 100 | 448810 | 101 | 448833 | 102 | 448915 |
| 103 | 448916 | 104 | 448917 | 105 | 448976 |
| 106 | 448977 | 107 | 448978 | 108 | 448979 |
| 109 | 449097 | 110 | 449110 | 111 | 449248 |
| 112 | 449263 | 113 | 449281 | 114 | 449291 |

| #   | Ser. No. | #   | Ser. No. | #   | Ser. No. |
|-----|----------|-----|----------|-----|----------|
| 115 | 449302   | 116 | 449351   | 117 | 449369   |
| 118 | 449411   | 119 | 449413   | 120 | 449523   |
| 121 | 449530   | 122 | 449531   | 123 | 449532   |
| 124 | 449652   | 125 | 449697   | 126 | 449702   |
| 127 | 449717   | 128 | 449718   | 129 | 449798   |
| 130 | 449800   | 131 | 449829   | 132 | 449867   |
| 133 | 449901   | 134 | 450680   | 135 | 451203   |
| 136 | 451377   | 137 | 451496   | 138 | 451746   |
| 139 | 452395   | 140 | 458566   | 141 | 458699   |
| 142 | 458760   | 143 | 459216   | 144 | 459217   |
| 145 | 459218   | 146 | 459506   | 147 | 459507   |
| 148 | 459521   | 149 | 459522   | 150 | 459788   |
| 151 | 460043   | 152 | 460081   | 153 | 460085   |
| 154 | 460120   | 155 | 460187   | 156 | 460240   |
| 157 | 460256   | 158 | 460274   | 159 | 460387   |
| 160 | 460394   | 161 | 460401   | 162 | 460556   |
| 163 | 460557   | 164 | 460591   | 165 | 460592   |
| 166 | 460634   | 167 | 460642   | 168 | 460668   |
| 169 | 460677   | 170 | 460711   | 171 | 460713   |
| 172 | 460743   | 173 | 460765   | 174 | 460766   |
| 175 | 460770   | 176 | 460793   | 177 | 460817   |
| 178 | 466887   | 179 | 466888   | 180 | 466890   |
| 181 | 466894   | 182 | 467045   | 183 | 467904   |
| 184 | 468044   | 185 | 468323   | 186 | 468324   |
| 187 | 468641   | 188 | 468736   | 189 | 468994   |
| 190 | 469056   | 191 | 469059   | 192 | 469078   |
| 193 | 469103   | 194 | 469106   | 195 | 469107   |
| 196 | 469108   | 197 | 469109   | 198 | 469355   |
| 199 | 469496   | 200 | 469517   | 201 | 469612   |
| 202 | 469623   | 203 | 469624   | 204 | 469626   |
| 205 | 470051   | 206 | 470052   | 207 | 470053   |
| 208 | 470054   | 209 | 470236   | 210 | 470447   |
| 211 | 470448   | 212 | 470476   | 213 | 470570   |
| 214 | 470571   | 215 | 471024   | 216 | 471191   |
| 217 | 471238   | 218 | 471239   | 219 | 471240   |
| 220 | 472066   | 221 | 472399   | 222 | 472462   |
| 223 | 472980   | 224 | 473213   | 225 | 473224   |
| 226 | 473484   | 227 | 473927   | 228 | 473996   |

| #   | Ser. No. | #   | Ser. No. | #   | Ser. No. |
| --- | -------- | --- | -------- | --- | -------- |
| 229 | 473997   | 230 | 473998   | 231 | 473999   |
| 232 | 474119   | 233 | 474139   | 234 | 474145   |
| 235 | 474146   | 236 | 474147   | 237 | 474496   |
| 238 | 474674   | 239 | 474963   | 240 | 474964   |
| 241 | 475341   | 242 | 475342   | 243 | 477547   |
| 244 | 477564   | 245 | 477570   | 246 | 477660   |
| 247 | 477711   | 248 | 477712   | 249 | 477805   |
| 250 | 477955   | 251 | 478044   | 252 | 478107   |
| 253 | 478544   | 254 | 478633   | 255 | 478767   |
| 256 | 478794   | 257 | 478858   | 258 | 478864   |
| 259 | 478908   | 260 | 479042   | 261 | 479215   |
| 262 | 479216   | 263 | 479217   | 264 | 479374   |
| 265 | 479375   | 266 | 479414   | 267 | 479523   |
| 268 | 479524   | 269 | 479667   | 270 | 480059   |
| 271 | 480060   | 272 | 480383   | 273 | 480392   |
| 274 | 480740   | 275 | 481074   | 276 | 482573   |
| 277 | 482574   | 278 | 482857   | 279 | 483054   |
| 280 | 483169   | 281 | 483174   | 282 | 483269   |
| 283 | 483980   | 284 | 484275   | 285 | 484276   |
| 286 | 484858   | 287 | 484865   | 288 | 485282   |
| 289 | 485283   | 290 | 485507   | 291 | 485775   |
| 292 | ******   | 293 | 486259   | 294 | 486265   |
| 295 | 486266   | 296 | 486297   | 297 | 487155   |
| 298 | 487397   | 299 | 487408   | 300 | 487410   |
| 301 | 487411   | 302 | 487428   | 303 | 487506   |
| 304 | 487516   | 305 | 487526   | 306 | 487536   |
| 307 | 487546   | 308 | 487556   | 309 | 487565   |
| 310 | 487649   | 311 | 487851   | 312 | 487895   |
| 313 | 487980   | 314 | 487981   | 315 | 487982   |
| 316 | 487984   | 317 | 488032   | 318 | 488058   |
| 319 | 488378   | 320 | 488383   | 321 | 488436   |
| 322 | 488438   | 323 | 488439   | 324 | 488619   |
| 325 | 488620   | 326 | 498002   | 327 | 511491   |

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on that copending applications since the referenced copending applications and the instant application are claiming common subject matter, as follows: a signal processing apparatus and method including an interactive communications system apparatus and method.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

A review of the claims in the related copending applications was made. These claims do not appear independent and distinct from the claims in this application. It is believed that CCPA in *Schneller* used the "independent and distinct" standard as the main factor in its determination that the double patenting rejection should be affirmed. The relevant arguments in the preceding paragraphs in support of this position are incorporated herein.

12. It is acknowledged that a multiplicity rejection was mailed on July 27, 1989 in parent file 07/096,096. In this rejection, the examiner had limited the applicants to 25 claims.        .

*Schneller* did not equate a multiplicity rejection with a restriction requirement as a permissible exception to being

subject to the non-obvious non--statutory double patenting

rejection.  For that reason, this action will not overturn the

legal reasoning in *Schneller* which supports the non-statutory

non-obviousness double patenting rejection above.

It is believed, however, that applicants arguments on this

multiplicity issue can be better supported if a nexis is

established between the claims of this application and those that

were cancelled in 07/096,096 in response to the multiplicity

requirement.

Notwithstanding the comment above, at the time the examiner

made the multiplicity rejection, there was a body of case law

that had overturned similar rejections.  Note *In re Flint* 162

USPQ 228 (CCPA 1969) and *In re Wakefield*, 164 USPQ 636 (CCPA

1970).

13.  The non-statutory double patenting rejection, whether of the
obvious-type or non-obvious-type, is based on a judicially
created doctrine grounded in public policy (a policy reflected in
the statute) so as to prevent the unjustified or improper
timewise extension of the "right to exclude" granted by a patent.
*In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re
Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam,*
686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi,* 759 F.2d
887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman,* 29 USPQ2d
2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR
1.321 (b) and (c) may be used to overcome an actual or
provisional rejection based on a non-statutory double patenting
ground provided the conflicting application or patent is shown to
be commonly owned with this application.  See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of
record may sign a Terminal Disclaimer.  A Terminal Disclaimer
signed by the assignee must fully comply with 37 CFR 3.73(b).

14.   Claims 6-29 are rejected under 35 U.S.C. 112, second
paragraph, as being indefinite for failing to particularly point
out and distinctly claim the subject matter which applicants
regards as the invention.

The examiner must be able to determine the meets and bounds
of the claims to perform an effective search and analysis over
the art.   The examiner is not certain that the meets and bounds
of these claims can be determined because of the language in the
disclosure and claims.   For example, the disclosure teaches many
transmitter and receiver stations, instruct signals, control
signals, decoders, etc.   (This is just a partial list of terms in
applicants' disclosure that apply to plural elements in that
disclosure.)   When these phrases are claimed, the examiner needs
to know "which" element in the disclosure is performing the
claimed step.   For example, when a hypothetical claim recites
"transmitter station", and the disclosure teaches different ones
(those in the origination, intermediate, and subscriber
stations), the examiner needs to be able to envision what
applicants could be claiming.

Applicants' assigned multiple meanings to words in a claim
makes a claim indefinite.

Traditionally, examiners "diagram" claims to determine the
meets and bounds.   To explain what "diagraming" means, the
examiner attempts to draw a picture (generally a circuit or a
connection of block elements in an electrical application) which

represents what was claimed so that the examiner can visualize

how a mythical reference could anticipate the claim, if the claim

was given its broadest reading.  If the claim recites terms or

phrases that have multiple meanings in the disclosure, the

examiner can't determine whether the diagram of the claim is

correct.  Given that, how can the examiner determine whether the

art, that could anticipate the broadest reading of the claim, was

searched for?

Admittedly, the size of applicants' disclosure with its

numerous possible implementations is contributing to the problem,

but the problem does exist.  Applicants are being requested to

reference the claim limitations in this application to the

disclosure so that the meets and bounds of these claims can be

properly considered.  This can be done in a remarks section, the

claims do not have to be amended.

15.  Claims 6-10, 16-18 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant

regards as the invention.

For claim 6, "a viewer interest" is recited twice in this

claim on lines 13-14 and line 24.  Does the applicant refer to a

same limitation?

For claim 16 recites the limitation "said remote transmitter

station" in line 2.  There is insufficient antecedent basis for

this limitation in the claim.   Claims 17-18 are rejected as being

dependent upon the rejected base claim 16.

16.   Claims 6-20, 23-29 are rejected under 35 U.S.C. 102(e) as

being anticipated by Boland et al. (US #4,484,218).

For claim 6, Boland discloses a method of generating and

delivering an individualized mass medium program (Col. 1, line 66

to Col. 2, line 25) presentation at a receiver station (Fig. 1,

distribution terminal 4), said receiver station having a receiver

(Col. 5, lines 2-4) for receiving a mass medium program signal, a

computer (Fig. 2, computer 23) for generating and communicating

information (Col. 16, lines 3-11), and one or more output devices

(Fig. 2, converters 18 and diplexers 19) operatively connected to

said receiver and said computer for delivering to a viewer a mass

medium program (Col. 5, lines 52-57) and computer information

(Col. 16, lines 3-11),  with said computer comprising one or more

data storage locations (Col. 5, lines 45-48), said method

comprising the steps of:

storing a timing signal (Col. 7, lines 5-9) and viewer

interest identification data (Col. 5, lines 45-49) specifying a

plurality of different viewer interest (Col. 5, lines 45-46);

controlling said computer a first time based on a comparison

of said viewer interest identification data to other data (Col.

5, lines 48-49), said first step of controlling comprising:

(a) inputting into said computer further data

designating a viewer interest (Col. 5, line 48);

(b) selecting a plurality of signals, each selected signal including a control signal respecting a different viewer interest (Col. 5, line 48);

(c) storing each selected signal at a storage location (Col. 5, line 49);

controlling said computer a second time based on said comparison, said second step of controlling comprising:

(a) selecting one or more computer programming information instructions (Col. 5, lines 48-50);

(b) generating mass medium program information content in respect to a viewer interest (Col. 5, lines 50-51);

(c) preparing to communicate generated mass medium program information content upon instruction (Col. 5, lines 52-53);

controlling said computer a third time based on said comparison, said third step of controlling comprising:

(a) selecting some mass medium program information content (Col. 5, lines 54-55);

(b) selecting a location (Col. 5, lines 55-56);

(c) communicating said selected mass medium program information content to said selected location (Col. 5, lines 55-56); and

presenting to a subscriber at a controlled time a mass medium program with locally generated mass medium program information content (Col. 5, lines 52-57), with said mass medium

program and said locally generated mass medium program

information content being outputted to said subscriber as

parallel presentation at a plurality of output devices (Col. 5,

lines 59-62).

For claim 7, Boland discloses a method of generating and

delivering an individualized mass medium program (Col. 1, line 66

to Col. 2, line 25) presentation at a receiver station (Fig. 1,

distribution terminal 4), said receiver station having a receiver

(Col. 5, lines 2-4) for receiving a mass medium program signal, a

computer (Fig. 2, computer 23) for generating and communicating

information (Col. 16, lines 3-11), and one or more output devices

(Fig. 2, converters 18 and diplexers 19) operatively connected to

said receiver and said computer for delivering to a viewer a mass

medium program (Col. 5, lines 52-57) and computer information

(Col. 16, lines 3-11), with said computer comprising one or more

data storage locations (Col. 5, lines 45-48), said method

comprising the steps of:

storing a timing signal (Col. 7, lines 5-9) and a plurality

of identification signals specifying different viewer interest

(Col. 5, line 49);

controlling said computer a plurality of times, each time

based on a comparison of identification signals to other data

(Col. 5, line 49; Col. 2, line 41), said first step of

controlling comprising:

(a) inputting further data designating a viewer

interest (Col. 5, line 48; Col. 2, line 41);

(b) selecting a signal, each selected signal including

a control signal respecting a mass medium program (Col. 5, line

50);

(c) storing each selected signal at a storage location

(Col. 5, line 49), some of said selected stored signals

designating different viewer interests;

controlling said computer one or more times based on a

comparison of said identification signal to other data, said

second step of controlling comprising:

(a) selecting one or more computer programming

information instructions (Col. 5, lines 48-50);

(b) generating mass medium program information content

in respect to a viewer interest (Col. 5, lines 50-51);

(c) preparing to communicate generated mass medium

program information content upon instruction (Col. 5, lines 52-

53);

controlling said computer one or more times based on a

comparison of said identification signal to other data, said

third step of controlling comprising:

(a) selecting some mass medium program information

content (Col. 5, lines 54-55);

(b) selecting a location (Col. 5, lines 55-56);

(c) communicating said selected mass medium program
information content to said selected location (Col. 5, lines 55-
56); and

presenting to a subscriber at a controlled time a mass
medium program with locally generated mass medium program
information content (Col. 5, lines 52-57), with said mass medium
program and said locally  generated mass medium program
information content being outputted to said subscriber as
parallel presentation at a plurality of output devices (Col. 5,
lines 59-62).

For claim 8, Boland discloses a method of generating and
delivering an individualized mass medium program (Col. 1, line 66
to Col. 2, line 25) presentation at a receiver station (Fig. 1,
distribution terminal 4), said receiver station having a receiver
(Col. 5, lines 2-4) for receiving a mass medium program signal, a
computer (Fig. 2, computer 23) for generating and communicating
information (Col. 16, lines 3-11), and one or more output devices
(Fig. 2, converters 18 and diplexers 19) operatively connected to
said receiver and said computer for delivering to a viewer a mass
medium program (Col. 5, lines 52-57) and computer information
(Col. 16, lines 3-11),  with said computer comprising one or more
data storage locations (Col. 5, lines 45-48), said method
comprising the steps of:

storing a timing signal (Col. 7, lines 5-9) and
identification data (Col. 5, lines 45-49), each identification

datum specifying a different viewer interest (Col. 5, lines 45-46);

controlling said computer a first time based on a comparison of said identification data to other data (Col. 5, lines 48-49), said first step of controlling comprising:

(a) inputting to said computer data designating a viewer interest (Col. 5, line 48);

(b) selecting a first signal, each selected first signal including a control signal respecting a mass medium program presentation (Col. 5, line 49);

(c) storing each selected first signal at a storage location (Col. 5, line 49);

controlling said computer a second time based on said comparison, said second step of controlling comprising:

(a) inputting data designating a viewer interest (Col. 5, line 49)

(b) selecting a second signal, each selected second signal including a control signal respecting a mass medium program presentation (Col. 5, line 50);

(c) communicating each selected second signal to a processor and a storage location (Col. 5, lines 54-55);

controlling said computer a third time based on said comparison, said third step of controlling comprising:

(a) inputting data designating a viewer interest (Col. 5, line 49);

(b) selecting a third signal, each selected third

signal including mass medium program information content and

control signal (Col. 5, line 55);

(c) communicating each selected third signal to a

processor and an output device (Col. 5, line 54); and

presenting to a subscriber a mass medium program with local

mass medium program information content (Col. 5, lines 52-57),

with said mass medium program and said local mass medium program

information content being outputted to said subscriber as

parallel presentation at a plurality of output devices (Col. 5,

lines 59-62).

For claim 9, Boland discloses a method of generating and

delivering an individualized mass medium program (Col. 1, line 66

to Col. 2, line 25) presentation at a receiver station (Fig. 1,

distribution terminal 4), said receiver station having a receiver

(Col. 5, lines 2-4) for receiving a mass medium program signal, a

computer (Fig. 2, computer 23) for generating and communicating

information (Col. 16, lines 3-11), and one or more output devices

(Fig. 2, converters 18 and diplexers 19) operatively connected to

said receiver and said computer for delivering to a viewer a mass

medium program (Col. 5, lines 52-57) and computer information

(Col. 16, lines 3-11), with said computer comprising one or more

data storage locations (Col. 5, lines 45-48), said method

comprising the steps of:

storing a timing signal (Col. 7, lines 5-9) and signal identification data designating a specific signal type (Col. 5, lines 45-49);

controlling said computer a first time based on a comparison of said signal identification data to other data (Col. 5, lines 48-49), said first step of controlling comprising:

(a) selecting a first signal, each selected first signal including a control signal respecting a mass medium program presentation (Col. 5, line 49);

(b) storing each selected first signal at a storage location (Col. 5, line 49);

controlling said computer a second time based on said comparison, said second step of controlling comprising:

(a) selecting a second signal, each selected second signal including a control signal respecting a mass medium program presentation (Col. 5, line 50);

(b) communicating each selected second signal to a processor (Col. 5, lines 54-55);

controlling said computer a third time based on said comparison, said third step of controlling comprising:

(a) identifying a third signal, each identified third signal being a control signal designating a signal type (Col. 2, line 41);

(b) communicating each identified third signal to a processor or an output device (Col. 5, line 54);

controlling said computer a fourth time based on said

comparison, said fourth step of controlling comprising:

(a) selecting a first signal (Col. 5, line 49); and

(b) communicating some mass medium program information

content in response to a control signal (Col. 5, lines 52-57);

and

presenting to a subscriber a mass medium program with local

mass medium program information content (Col. 5, lines 52-57),

with said mass medium program and said local mass medium program

information content being outputted to said subscriber as

parallel presentation at a plurality of output devices (Col. 5,

lines 59-62).

For claim 10, Boland discloses a method of generating and

delivering an individualized mass medium program (Col. 1, line 66

to Col. 2, line 25) presentation at a receiver station (Fig. 1,

distribution terminal 4), said receiver station having a receiver

(Col. 5, lines 2-4) for receiving a mass medium program signal, a

computer (Fig. 2, computer 23) for generating and communicating

information (Col. 16, lines 3-11), and one or more output devices

(Fig. 2, converters 18 and diplexers 19) operatively connected to

said receiver and said computer for delivering to a viewer a mass

medium program (Col. 5, lines 52-57) and computer information

(Col. 16, lines 3-11), with said computer comprising one or more

data storage locations (Col. 5, lines 45-48), said method

comprising the steps of:

storing a timing signal (Col. 7, lines 5-9) and a plurality

of a first data, each first datum designating a different type of

signal (Col. 2, lines 38-42);

controlling said computer one or more times based on a

comparison (Col. 5, lines 48-49), said first step of controlling

comprising:

(a) selecting a first signal, each selected first

signal including a control signal respecting a mass medium

program presentation (Col. 5, line 49);

(b) storing each selected first signal at a storage

location (Col. 5, line 49);

controlling said computer one or more times based on a

comparison, said second step of controlling comprising:

(a) selecting a second signal, each selected second

signal including a control signal respecting a mass medium

program presentation (Col. 5, line 50);

(b) communicating each selected second signal to a

processor or an output device (Col. 5, lines 54-55);

controlling said computer one or more times based on a

comparison, said third step of controlling comprising:

(a) identifying a third signal, each identified third

signal being a control signal designating a signal type (Col. 2,

line 41);

(b) communicating each identified third signal to a

processor or an output device (Col. 5, line 54);

controlling said computer one or more times based on a

comparison, said fourth step of controlling comprising:

(a) selecting a first signal (Col. 5, line 49); and

(b) communicating some mass medium program information

content in response to a control signal (Col. 5, lines 52-57);

and

presenting to a subscriber a mass medium program with local

mass medium program information content (Col. 5, lines 52-57),

with said mass medium program and said local mass medium program

information content being outputted to said subscriber as

parallel presentation at a plurality of output devices (Col. 5,

lines 59-62).

For claim 11, Boland discloses a method of providing data of

interest to a receiver station (Fig. 1, distribution terminal 4)

from a remote data source (Fig. 1, subscriber terminal 6), said

data of interest for use at the receiver station in generating or

outputting a receiver specific datum (Col. 5, lines 49-57), said

method comprising the steps of :

storing data at said remote data source (Col. 5, line 44);

receiving at said remote data source a query from said

receiver station (Col. 5, lines 44-45);

transmitting said data from said remote data source to said

receiver station in response to said step of receiving said

query, said receiver station selecting and storing some of said

transmitted data (Col. 5, lines 47-49);

transmitting from a second remote source (Fig. 1, head end

1) to said receiver station a signal (Col. 2, lines 16-25, 38-42)

which controls said receiver station to select and process an

instruct signal (Col. 5, lines 52-54) which is effective at said

receiver station to coordinate presentation of said data with a

second predetermined presentation sequence (Fig. 2, LUT data of

the computer 23).

For claim 12, Boland discloses a method of communicating

subscriber station information from a subscriber station to one

or more remote data collection stations, said method comprising

the steps of:

inputting a viewer's or participant's reaction at a

subscriber station (Col. 5, lines 41-43);

receiving at said subscriber station information that

designates an instruct signal to process or an output to deliver

in consequence of subscriber input (Col. 10, lines 30-40);

determining the presence of said subscriber input at said

subscriber station by processing said viewer's or participant's

reaction (Col. 10, lines 48-52);

processing an instruct signal which is effective to

coordinate presentation of data with a second predetermined

presentation sequence at said subscriber station in consequence

of said step of determining (Col. 5, lines 49-52);

transferring from said subscriber station to one or more

remote data collection stations (Fig. 1, head end 1) an indicia

confirming delivery of said instruct signal from said step of

processing or confirming delivery of said effect from said step

of processing (Col. 2, lines 42-45).

For claim 13, Boland discloses that the instruct signal is

input by a subscriber (Col. 5, lines 41-44), said method further

comprising the steps of:

storing a subscriber instruction to receive one or more

specific mass medium programs, data, news items, or computer

control instructions (Col. 5, lines 41-44); and

receiving one or more specific mass medium programs, data,

news items, or computer control instructions in accordance with

said instruction (Col. 5, lines 49-57).

For claim 14, Boland discloses that the instruct signal is

input by a subscriber (Col. 5, lines 41-44), said method further

comprising the steps of:

storing a subscriber instruction to receive one or more

specific mass medium programs, data, news items, or computer

control instructions in a specific fashion (Col. 5, lines 41-44);

and

receiving one or more specific mass medium programs, data,

news items, or computer control instructions in accordance with

said instruction (Col. 5, lines 49-57)

For claim 15, Boland discloses that the information that

designates a specific subscriber input or said instruct signal is

detected in an information transmission from a data of

programming source (Col. 5, lines 41-44), said method further

comprising the steps of:

programming a processor to respond to information

communicated from a data or programming source (Col. 5, lines 41-

44);

receiving an information transmission from a data or

programming source (Col. 5, lines 41-43);

inputting at least some of said information transmission to

a control signal detector (Col. 5, line 44);

detecting data or an instruct signal in said information

transmission (Col. 5, line 44); and

passing said detected data or instruct signal to said

processor (Col. 5, line 44).

For claim 16, Boland discloses a method for controlling a

remote intermediate data transmitter station (Fig. 1,

distribution terminal 4) to communicate data to one or more

receiver stations (Fig. 1, subscriber stations 6), with said

remote transmitter station including a broadcast or cablecast

transmitter for transmitting data (Fig. 2, converters 18), a

plurality of selective transmission devices each operatively

connected to said broadcast or cablecast transmitter for

communicating data (Fig. 2, diplexers 19), a data receiver (Fig.

2, filters 16, 25), a control signal detector (Fig. 2, VRAM 28),

and a computer capable of controlling one or more of said

selective transmission devices (Fig. 2, computer 23), and with

said remote transmitter station adapted to detect one or more

control signals, to control the communication of data in response

to one or more detected control signal, and to deliver data at

its broadcast or cablecast transmitter (Col. ), said method of

communicating comprising the steps of:

receiving data to be transmitted by the remote intermediate

data transmitter station and delivering said data to a

transmitter, said data comprising an instruct signal which is

effective at the receiver station to coordinate presentation of

said data with a second predetermined presentation sequence (Col.

7, lines 10-30);

receiving one or more control signals which at the remote

intermediate data transmitter station operate to control the

communication of said data (Col. 7, lines 10-30); and

transmitting said one or more control signals to said

transmitter before a specific time (Col. 7, lines 5-7).

For claim 17, Boland discloses that the specific time is a

scheduled time of transmitting said data at said remote

intermediate data transmitter station (Col. 7, lines 5-7).

For claim 18, Boland discloses the step of embedding a

specific one of said one or more control signals in said data

before transmitting said data to said remote transmitter station

(Col. 7, lines 63-66).

For claim 19, Boland discloses a method of controlling a

receiver station including the steps of:

detecting the presence or absence of a broadcast or
cablecast control signal (Col. 7, line 59 to Col. 8 line 12);

inputting an instruct-to-react signal to a processor based
on said step of detecting the presence or absence of a control
signal (Col. 7, lines 64-65; Col. 8, lines 1-2);

controlling said processor to output specific information in
response to said step of inputting an instruct-to-react-signal
(Col. 5, lines 45-57);

coordinating presentation of data with a second
predetermined presentation sequence on the basis of information
received from said processor based on said step of controlling a
processor (Col. 5, lines 45-57).

For claim 20, Boland discloses that a buffer is operatively
connected to said processor for buffering input, and the method
further comprising the step of inputting said instruct-to-react
signal directly to said processor (Col. 8, lines 6-8).

For claim 23, Boland discloses a method of controlling a
receiver station (Fig. 1, distribution terminal 4), said receiver
station having a processor (Fig. 2, computer 23) for passing and
executing instruction and a clock operatively connected to said
processor (Fig. 2, Sync 27) for inputting a timing signal, said
method comprising the steps of:

receiving a broadcast or cablecast transmission (Col. 5,
lines 45-46);

demodulating said broadcast or cablecast transmission to

detect an information transmissions thereon, said information

transmission comprising an instruct signal which is effective to

coordinate presentation of said data with a second predetermined

presentation sequence (Col. 5, lines 46-57);

detecting said instruct signal on said information

transmission and passing said instruct signal to said processor

(Col. 7, lines 61-68);

delaying, under processor control, the passing of said

instruct signal to a controllable apparatus (Col. 7, lines 61-

68);

passing said instruct signal to said controllable apparatus

on the basis of a timing signal (Col. 7, lines 5-7; Col. 8, 4-

12);

controlling said controllable apparatus based on said

instruct signal (Col. 8, lines 13-16).

For claim 24, Boland further discloses the steps of:

detecting a timing signal in said information

transmission(Col. 3, lines 52-55);

passing said timing signal to said clock (Col. 3, lines 55-

60);

timing, under control of said clock, the passing of said

instruct signal based on said timing signal (Col. 3, lines 55-

60).

For claim 25, Boland discloses a method of communicating
data and update material to one or more mass medium programming
receiver stations (Fig. 1, distribution terminal 4) each of which
includes a broadcast or cablecast data receiver (Fig. 2,
converters 18), a data storage device (Fig. 2, VRAM 28), a
control signal detector (Fig. 2, VRAM 28), and a computer capable
of processing data (Fig. 2, computer 23), and with each said
receiver station adapted to detect and respond to one or more
instruct signals and to store data for subsequent processing,
said method of communicating comprising the steps of:

receiving data to be transmitted and delivering the data to
a transmitter (Col. 6, lines 11-22);

receiving one or more instruct signals which at the receiver
station are effective to coordinate presentation of said data
with a second predetermined presentation sequence (Col. 5, lines
41-57);

transferring said one or more instruct signals to a
transmitter (Col. 5, line 66 to Col. 6, line 10);

transmitting an information transmission comprising said
data and said one or more instruct signal (Col. 6 line 9-10).

For claim 26, Boland discloses the step of embedding one or
more instruct signals in a television signal (Col. 7, lines 63-
66).

For claim 27, Boland discloses the step of transmitting
directs said broadcast or cablecast transmission to a plurality

of receiver stations at the same time and each of said plurality

of receiver stations receives or responds to said one or more

instruct signals concurrently (Col. 13, line 49 to Col. 14, line

35).

For claim 28, Boland discloses the step of transmitting

directs said broadcast or cablecast transmission to a plurality

of receiver stations at different times and each of said

plurality of receiver stations receives or responds to said one

or more instruct signals at a different time (Col. 7, lines 5-7).

For claim 29, Boland discloses the steps of receiving said

data unit at a receiver in the transmitter station, communicating

said data unit from said receiver to a memory location, and

storing said data unit at said memory location for a period of

time prior to communicating said data unit to a transmitter (Col.

5, line 41 to Col. 6, line 10).

17. A series of interviews were held before prosecution began on

this application. Unless identified specifically below in this

part of the action, these interviews did not address the merits

of any single application, but rather issues that are appropriate

to all of the related "Harvey" applications.

The first interview was held on August 13, 1995. It was a

personal interview. Attending were one of the applicants, Mr.

Harvey, and his attorneys, Messrs. Scott and Woolston.

Representing the PTO were Messrs. Godici, Yusko, Orsino, and

Groody. Mr. Harvey and his attorneys were informed that because

of the large number of related applications, the examination
would be performed by a team of examiners.  As of the August 1995
interview there existed a problem with some of the applications
being charged large entity fees when applicants believed that
small entity status was deserved.  The PTO has referred this
matter to the Office of Assistant Commissioner of Patents,
specifically Hiram Bernstein, a petitions attorney.  Mr. Harvey's
representatives will attempt to resolve this issue through Mr.
Bernstein.  At this time all of the related cases had not been
received in the Group.  No examination was planned until at least
late October because the team members were managers, and needed
to complete other end of fiscal year assignments and all employee
performance ratings.  The PTO requested that any amendments to
the specification, other that to correct continuing status, be
delayed.  Mr. Harvey's representatives stated that no other
amendments to the specification were actually planned.  The PTO's
goal will be to attempt to reduce the amount of paper passed
between applicant and PTO since the cases are related and very
difficult to move from cite to cite because of their size.
Copies of the prior art only need to be filed once.  The PTO will
only send newly cited art once.  Preliminary amendments are being
prepared.  The PTO however cautioned that the prosecution of the
applications will not be delayed until applicants have filed
these amendments.  The PTO requested a chart establishing any
relationships between cases and what parts of applicants'

disclosure related blocks of cases were directed to.  It was not,

at this time, determined whether this chart would become part of

the official file.  The PTO planned to research this.  It was the

PTO's intent to examine related cases simultaneously.  The PTO

welcomed any claim amendments to include resubmissions of all

claims, whether amended or not.  Mr. Harvey's representatives

were informed that the issue of double patenting was expected to

be a major issue.

On November 2, 1995, a telephonic interview was held between

Mr. Woolston and Mr. Groody.  Mr. Woolston indicated that two

prior art statements were being completed, one for cases with a

1987 effective date, the other for cases with a 1981 effective

date.

On November 30, 1995, a personal interview was held.

Representing applicants were Messrs. Scott, Woolston, and

Grabarek.  Representing the PTO were Messrs. Yusko, Orsino, and

Groody.  The content of a simultaneously filed prior art

statement was discussed.  The PTO's copies of the parent files

are missing the non-U.S. patents cited therein.  The PTO

requested copies of those prior art documents.  Applicants gave

the PTO a document showing which cases have already been amended.

Since this document merely shows the status of any amended

application, it has not been made part of the file record since

that paper has no bearing on the merits of any issue before the

PTO.

A second interview was held on later on November 30, 1995 between Mr. Scott and Mr. Groody. The sole topic discussed was double patenting. The discussion led to no conclusions on whether a double patenting rejections would be made in these applications.

An interview was held on December 6, 1995 between Mr. Scott and Mr. Groody. The discussion was directed to In re Schneller, 158 USPQ 210 (CCPA) and whether that decision will necessitate a double patenting rejection in any of these cases. Mr Scott was asked whether a terminal disclaimer could be filed in all of the 327 related cases to obviate a possible double patenting rejection in each of these cases over each other. Mr. Scott agreed to consider this.

An interview was held on December 13, 1995 between Mr. Scott and Mr. Groody regarding the terminal disclaimer question above. Mr. Scott proposed filing a terminal disclaimer in about 250 of the 327 cases over each other if the PTO would have each of the about 250 issue within 4 or 6 months of each other. Mr. Groody felt that the PTO would be unwilling to suspend prosecution in some cases just to have other related cases issue close to each other. No agreement was reached.

Two interviews were held between Mr. Scott and Mr. Groody on April 2, 1996. Mr. Scott pointed out that, in parent file 5,233,654, there had been a restriction requirement. After reviewing the file, Mr Groody indicated that there would not be a

Schneller double patenting rejection made in any case based on parent patent 5,233,654 and 5,335,277. The action recently sent out in 08/113,329 would be changed to reflect this point. Mr. Scott inquired whether a terminal disclaimer, in these applications, would have to be filed for all of the four Harvey patents (4,694,490; 4,704,725; 4,965,825; 5,109,414). Mr. Groody felt that all four should be disclaimed, if applicants elect to take that approach toward overcoming the double patenting rejections, because of the requirement in terminal disclaimers concerning common ownership. Mr. Scott indicated that in parent patent 4,965,825, there had been a multiplicity rejection. Mr. Groody will order the file, but felt that rejection would not overcome the Schneller double patenting rejections since the CCPA did not list this situation as an acceptable reason to file continuing cases. The Court limited it exception to "independent and distinct" claims. Mr. Groody acknowledged that the Board of Appeals may accept the multiplicity argument, but, in the absence of case law on this issue, he would still apply the Schneller rejections.

On June 10, 1996, Mr Scott spoke with Mr. Groody on several topics. Related case 08/397,582 has been withdrawn from issue in Group 2200, and a new action will be mailed containing a double patenting rejection under *In re Schneller*. This application will now be examiner in Group 2600. Mr. Scott questioned whether applicants can withdraw the terminal disclaimer made in 397,582.

Mr. Groody was unsure of the answer, but later checked with Mr.

Orsino, who informed him that MPEP 1490 controlled.

Mr. Groody still believes that 08/113,329 can be expedited

at the Board.  Mr. Scott can refer to the appeal brief to be

filed in that case in responding to any application having a

*Schneller* double patenting rejection.

A telephone interview was held on June 12, 1996 between Mr.

Thomas Woolston and Marc E. Bookbinder representing the PTO.  For

S.N. 08/448,116, Mr. Woolston indicated that the supplemental

preliminary amendment of Nov. 13, 1995 was incomplete and that a

complete version of such would be filed shortly to perfect the

submission as originally intended.  Mr. Woolston also indicated

that he intended to file a second supplemental preliminary

amendment in this case bringing the total number of claims to 37.

Mr. Bookbinder indicated that the Group would like to have a

complete grouping of applications in a manner that was submitted

earlier for only a portion of the total filings.  Mr. Woolston

stated that such a grouping was available and that he would

forward it to the Group as soon as possible.

Mr. Bookbinder requested that each future amendment filed be

accompanied by an electronically readable version thereof.  Mr.

Woolston stated that he could provide a disk to include one or

more amendments made to applications as they were filed.

Mr. Woolston stated that he has reviewed actions that have

been mailed and that he takes issue particularly with the double

patenting rejections and the way In re Schneller has been

applied. Mr. Bookbinder suggested that Mr. Woolston contact Mr.

Groody of Group 2600 to discuss the particulars of the double

patenting rejections since he was the author of those rejections.

On November 25, 1996, a telephone interview was held between

Mr. Scott and Mr. Groody.  Mr. Groody informed Mr. Scott that

expedited processing at the Board for 113/329 would be arranged

by the Office.  No action on applicants' part was necessary.

Applicants no longer had to submit a listing of related cases,

since the examiners did not need that.  Finally, 397,582, which

has been withdrawn from issue, will be examined over all of the

art cited in all of the later filed Harvey cases.

18.  The art cited in the information disclosure statements

submitted by applicants has been considered.  The examiner

initialed 1449 forms will be sent in a later action.

19.  Any inquiry concerning this communication or earlier

communications from the examiner should be directed to James

Groody whose telephone number is (703) 308-5461.

Any inquiry of a general nature or relating to the status of

this application should be directed to the Group receptionist

whose telephone number is (703) 305-4700.

James J. Groody
Supervisory Patent Examiner
Art Unit 262
SP 2600